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Date of Signature and Deposit: September 11, 2006

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Dean DellaPenna  
David K. Shintani

Date: September 11, 2006

Serial No.: 10/674,767

Art Unit: 1638

Filed: 09/30/2003

Examiner: Russell Kallis

For: TRANSGENIC PLANTS WITH  
TOCOPHEROL METHYLTRANSFERASE

Docket No.: 920905.90024

Confirmation No.: 5481

RESPONSE TO RESTRICTION REQUIREMENT

Mail Stop Amendment  
Commissioner for Patents  
P O Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

In an Office Action mailed September 7, 2006, the Examiner in charge of the above-noted application imposed a requirement for restriction dividing the claims into two groups, which in the Examiner's opinion are not related.

In response, Applicants provisionally elect Group I, which includes Claims 13-14, 16-18 and 20. The requirement, however, is respectfully traversed because it is believed that the subject matter of Group I and of Group II (Claims 15, 19 and 21) are not patentably distinct. Applicants submit that the subject matter of the two groups are linked in that the primary purpose of generating the transgenic plants and the transgenic seeds of Group I is to produce the oils of Group II.

Furthermore, Applicants believe that a proper search for one group of claims would inevitably overlap with that for the others and the search results for one is relevant to the others. Applicants do not believe that a burden exists for searching more than one of the patentably related groups. Applicants also wish to note that procedurally restriction requirements are optional in all cases (see MPEP § 803). If the search and examination of a claim set can be made

without serious burden, the Examiner must examine the claims on the merits, even though they may be arguably directed at distinct or independent inventions (MPEP § 803). In the present application, and as described hereinabove, it is respectfully submitted that claims in Groups I and II can be examined together without serious burden on the Office. Accordingly, it will be unnecessarily burdensome on both the applicants and the Office to consider this highly related subject matter in several separate patent applications.

The Examiner also imposed a requirement for election of SEQ ID NO:1 or SEQ ID NO:2 if Applicants elected Group I. Applicants, however, believe that the Examiner actually meant to request that Applicants elect a nucleic acid sequence from SEQ ID NO:1 and SEQ ID NO:3, as SEQ ID NO:1 and SEQ ID NO:2 are both directed to *Synechocystis*. Accordingly, Applicants provisionally elect SEQ ID NO:3 (*Arabidopsis*).

The requirement is respectfully traversed because the nucleic acid sequences are not patentably distinct; that is, SEQ ID NO:1 and SEQ ID NO:3 are functionally and structurally related. Applicants submit that the two sequences are linked, as SEQ ID NO:1 was used to isolate SEQ ID NO:3 (*see* p. 9, lines 20-23 and pp. 16-17, Example 5). In addition, Applicants note that proteins encoded by SEQ ID NO:1 and by SEQ ID NO:3 are 35% identical and 66% similar (*see* FIG. 1 and p. 17, lines 4-6), and have conserved S-adenosyl-methionine (SAM) binding motifs (*see* FIG. 1). Furthermore, Applicants note that SEQ ID NO: 1 was originally isolated using an *Arabidopsis* gene (*see* p. 12, Example 1). Finally, the Applicants note that SEQ ID NO:1 and SEQ ID NO:3 functioned similarly in an *E. coli* expression system (*see* p. 19-23, Example 7). Thus, Applicants should not be unreasonably forced to make such an election.

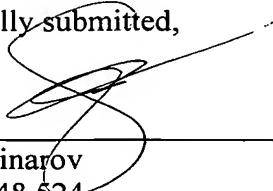
Again, this election is made with traverse and without prejudice to the eventual filing of a divisional application and rejoinder of any of the non-elected groups back into the application.

No extension of time is believed due, but should any extension be due, in this or any subsequent response, please consider this to be a petition for the appropriate extension and a request to charge the extension fee to Deposit Account No. 17-0055. No additional fees are

Application No.: 10/674,767  
Response dated: September 11, 2006  
Reply to Office Action dated: September 7, 2006

believed due; however, if any fees are due, in this or any subsequent response, please charge  
Deposit Account 17-0055.

Respectfully submitted,



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